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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,063	10/01/2003	Jennifer X. Qiao	PH 7500 NP	8093
23914	7590	11/28/2005	EXAMINER	
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			HOFFMAN, LEXINGTON A	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,063

Applicant(s)

QIAO ET AL.

Examiner

Lexington A. Hoffman

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/01/03, 2/19/04</u> | 6) <input type="checkbox"/> Other: _____ |

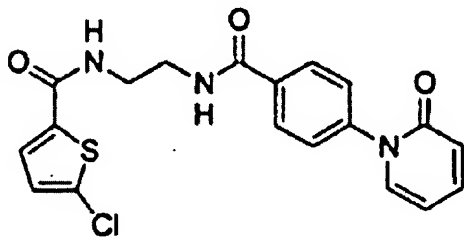
DETAILED ACTION

Priority

This application claims benefit of 60415366, filed 10/2/02, and 60417208, filed 10/9/02.

Election/Restrictions

In response to the election/restriction requirement, applicant elected with traverse, group I (compounds), and elected the following species for examination



purposes:

The breadth of compounds encompassed by the claims constitutes an improper Markush group. In a proper Markush group, the compounds share a common structure and a common utility. The compounds embraced by the instant claims do not all share a common utility. For example RN 607397-93-3 has a structure encompassed by claim 1 but is used as an integrin inhibitor in the treatment of inflammatory disease, whereas the instant are factor Xa inhibitors. Accordingly, to limit the scope of the claims, the Markush options disclosed in claim 7 and the species in claim 8 were searched; the remaining claims were considered to the extent which claims 7 and 8 read upon them.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-7, 10 are rejected under 35 USC 102(a) as being anticipated by Dorsch, et al., in WO/0248099 (published 6/2/02). The instant claims are anticipated by the compound RN 438054-61-6 CAPLUS (see STN results). The instant claims are also anticipated by RN 438054-63-8, and RN 438055-66-4 (see STN results).

Claim Objections

Claim 9 is objected to as containing non-elected subject matter (in part). The extent of claim 9 that claims 7 and 8 read upon is free of the art.

Allowable Subject Matter

The species claimed in claim 8 are free of the art. While the allowable subject matter is similar to compounds claimed in Dorsch, et al. (ref. previously cited), the pattern of substitutions on the chain and the nature/substitutions of the terminal ring(s) differs. Lacking is the motivation to modify the prior to arrive at the instant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lexington A. Hoffman whose telephone number is 571-272-4328. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lexington Hoffman
Art Unit 1625

11/22/05

LH


Cecilia Tsang
Supervisory Patent Examiner
Art Unit 1625